REMARKS

Claims 16-20 would remain pending upon entry of this amendment. The cancellation of claims 1-15 obviates the rejections thereof.

Because the cancellation of claims 1-15 would improve this application's condition for appeal by obviating the rejections for these claims, Applicants respectfully request entry of this Amendment After Final

In the Final Office Action, the Examiner rejected claims 1-5 and 16-20 under 35 U.S.C. § 101; and rejected claims 1-20 under 35 U.S.C. § 103(a) as being unpatentable over Nelson et al. (U.S. Publication No. 2004/0236830 A1) in view of King et al. (U.S. Patent No. 5,600,775).

§ 101 Rejection:

Regarding the § 101 rejection, Applicants respectfully note that the response on pages 19 and 20 of the Final Office Action adds nothing of substance to the rejection and certainly does not answer Applicants' traversal. It continues to complain that method claims 16-20 "are not limited to tangible embodiments" and "fail to set forth physical structures or materials comprising of hardware." Again, this is a "machine implemented test," which is not a proper test for subject matter eligibility. See again Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility (22 November 2005), Annex III "Improper Tests For Subject Matter Eligibility," section d) "Machine Implemented Test": "a finding that a claim fails to recite a computer-implemented process is not determinative in whether that claim passes muster under Sec. 101." This continues to be clear legal error.

Processes (including their component steps or acts) are *prima facie* statutory. See the

quoted portion of 35 U.S.C. § 101 on page 19 of the Final Office Action: ". . . any new and

useful process . . ." The undersigned knows of no statutory or case law requirement that a

process or method claim state exactly what physical structures are used to perform its component

steps or acts. This is because there is no such requirement. If the Examiner knows of such a

requirement, he is respectfully requested to document it. Otherwise, the Examiner should

withdraw this legally erroneous position.

The proper focus for the Examiner should be whether the claimed invention has "specific

and substantial" utility (see M.P.E.P. § 2107.02). As noted therein, "In most cases, an

applicant's assertion of utility creates a presumption of utility that will be sufficient to satisfy the

utility requirement of 35 U.S.C. 101" M.P.E.P. § 2107.02(III)(A). In this context, method

claims 1-5 and 16-20 plainly have well-established, specific and substantial utility in view of the

disclosure of, for example, the media stream 105, media device 110, input device 170, and

display device 180 in Fig. 1 of the specification (and their associated description).

If the Examiner persists in a § 101 rejection, he is respectfully requested to address and

factually support his various burdens under M.P.E.P. § 2107.02(IV). These are listed on pages

2100-31 and 2100-32 of the M.P.E.P., 8th Ed., Rev. 5, Aug. 2006. A *prima facie* showing of lack

of utility has not been made to date, and if the Examiner persists in this rejection, he should do

Applicants the courtesy of following the requirements (note the repeated use of the word "must")

laid out by M.P.E.P. § 2107.02(IV) so that the rejection may be properly addressed.

§ 103 Rejection:

Applicants again note that, the Office Action is insufficient to establish a *prima facie* case of obviousness. For example, contrary to page 10 of the Final Office Action, the "outputting stored media information . . ." limitation is not read on either of Nelson et al. or King et al. in the rejections of claims 1, 7, and 12. Given that there is only one independent claim remaining, Applicants respectfully request a specific and detailed reading of each of its limitations on the applied references to improve the record for appeal.

A *prima facie* case of obviousness has not been established for claims 16-20 at least because the references as combined fail to teach or suggest all the claim limitations. Claims 16-20 require a method including, inter alia, "outputting stored media information based on an associated index file; receiving an annotation request at a point in the index file; and modifying the index file at the point at which the annotation request was received to reference the stored annotation information." The combination of Nelson et al. and King et al. fails to teach or suggest at least these limitations.

Regarding the "outputting stored media information based on an associated index file; and receiving an annotation request at a point in the index file" limitations, Nelson et al. fails to teach or suggest these, because it only discloses annotating a real-time video conference. See, for example, paragraph 0068. Thus, Nelson et al. fails to teach or suggest "receiving an annotation request at a point in the index file" on whose basis "stored media information" is output, as required by claims 16-20.

Also, neither reference teaches or suggests "modifying the index file at the point at which the annotation request was received to reference the stored annotation information." <u>Nelson et al.</u> does not teach or suggest this, because it fails to teach the "index file" on whose basis "stored media information" is output. Thus, it cannot logically teach or suggest "modifying" such an index file, as required by claims 16-20.

As previously explained, and not addressed by the Final Office Action, <u>King et al.</u> actually teaches away from modifying an index of media information, as claimed. <u>King et al.</u> provides at col. 2, lines 17-31 (with emphasis added):

> The method includes displaying the file of indexed data structures using a file display routine, and selecting in response to user input an indexed data structure to be annotated from the file of indexed data structures being displayed. **Next, an annotation data structure is created** in response to user input using an annotation routine **without modifying the selected data structure.** The annotation data structure includes a graphical element for display overlaying the selected data structure and an indication of an index value for the selected data structure. **The annotation data structure is stored in an annotation file apart from the file of indexed data structures.**

The cited portion of <u>King et al.</u> teaches creating a separate annotation data structure "without modifying the selected [indexed] data structure." This teaches directly away from "modifying the index file at the point at which the annotation request was received to reference the stored annotation information" as required by claims 16-20.

Thus, a *prima facie* case of obviousness has not been established for claims 16-20, and the 35 U.S.C. § 103(a) rejection should be withdrawn.

Reconsideration and allowance of pending claims 16-20 are respectfully requested.

In the event that any outstanding matters remain in this application, Applicants request

that the Examiner contact Alan Pedersen-Giles at the number below to discuss such matters.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is

hereby made. Please charge any shortage in fees due in connection with the filing of this paper,

including extension of time fees, to Deposit Account No. 50-0221 and please credit any excess

fees to such deposit account.

Respectfully submitted,

Dated: <u>October 31, 2006</u>
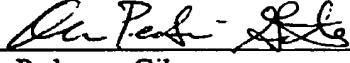
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